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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,827	07/16/2003	Kenneth McClintock	24168067.5	1255
23562	7590	04/26/2005	EXAMINER	
BAKER & MCKENZIE PATENT DEPARTMENT 2001 ROSS AVENUE SUITE 2300 DALLAS, TX 75201			BUI, LUAN KIM	
			ART UNIT	PAPER NUMBER
			3728	
DATE MAILED: 04/26/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

2P

<b>Office Action Summary</b>	<b>Application No.</b> 10/620,827	<b>Applicant(s)</b> MCCLINTOCK, KENNETH	
	<b>Examiner</b> Luan K Bui	<b>Art Unit</b> 3728	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/25/03 &amp; 4/22/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

***Drawings***

1. The drawings are objected to because the drawings are not clear and showing details of the invention. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 7, 11 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Nava et al. (6,302,288; hereinafter Nava'288). Nava'288 discloses a system for storing a promotional item comprising a container (8) having an openable orifice (12) on a portion of the container, a cover piece (14) removably coupled over the orifice and the cover piece creating an enclosed storage space between the openable orifice and the cover piece and a promotional item (16) housed in the enclosed storage space (Figures 1-3). Nava'288 further discloses the cover piece is opaque (column 11, lines 36-42). Claims 11 and 17 are anticipated by the method of using the system of Nava'288.

4. Claims 1, 2, 6, 7, 9, 11, 12, 16, 17 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Grul et al. (2004/0050724; hereinafter Grul'724). Grul'724 discloses a system for storing a promotional item comprising a container such as a soft-drink can (50) having an openable orifice on a portion of the container, a cover piece (51) removably coupled over the orifice and the cover piece creating an enclosed storage space between the openable orifice and the cover piece and a promotional item (52) housed in the enclosed storage space (Figures 5-11). Grul'724 further discloses the cover piece is opaque (page 5, paragraph 0096), the promotional item comprises computer games and the cover piece comprises a pull-tab (57, 77). Claims 11, 12, 16, 17 and 19 are anticipated by the method of using the system of Grul'724.

5. Claims 1, 2, 6-9, 11, 12 and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Falkenberg et al. (2002/0144913; hereinafter Falkenberg'913). Falkenberg'913

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discloses a system for storing a promotional item comprising a container such as a soft-drink can (1) having an openable orifice (8) on a portion of the container, a cover piece (5) removably coupled over the orifice and the cover piece creating an enclosed storage space between the openable orifice and the cover piece and a promotional item disposed within a pouch (25) housed in the enclosed storage space (Figures 1 and 8). Falkenberg'913 further discloses the promotional item comprises coupons or others (page 2, paragraph 0019) and the cover piece comprises a pull-tab (7). Claims 11, 12, 16-19 are anticipated by the method of using the system of Falkenberg'913.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-5, 8, 10, 13-15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grul et al. (2004/0050724; hereinafter Grul'724) or Falkenberg et al. (2002/0144913; hereinafter Falkenberg'913) in view of Fiala et al. (2003/0004889; hereinafter Fiala'889). Grul'724 or Falkenberg'913 discloses the system for storing the promotional item as above having all the limitations of the claims except for the promotional item comprises an internet address printed thereon. Fiala'889 teaches a system for storing a promotional item comprising a package (1.20, 1.66, 1.68) for holding a CD (1.62) and a card (1.78) having an internet address printed thereon to direct the user to an internet address that the product may be

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registered (Figure 1). It would have been obvious to one having ordinary skill in the art in view of Fiala'889 to modify the system of Grul'724 or Falkenberg'913 so the promotional item comprises an internet address printed thereon or the cover comprises an internet address printed thereon that associated with an internet site of an entity related to the promotional item to allow the system for promoting various types of items and to allow visual access to the internet address printed on the cover piece. As to claim 5, Falkenberg'913 discloses the cover piece comprises promotional material on an exposed side of the cover piece (Figure 1). Claims 13-15 and 20 are drawn to the obvious method of using the system of either Grul'724 or Falkenberg'913 as modified.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (571) 272-4552. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Ms. Marilyn Watts at (571) 272-4398.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 306-5648. Facsimile correspondence for this application should be sent to (703) 872-9306 for Formal papers and After Final communications.

lkb  
April 24, 2005



Luan K. Bui  
Primary Examiner